

Question Q217

National Group: The Finnish AIPPI group

Title: The patentability criterion of inventive step / non-obviousness

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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Level of inventive step / non-obviousness

1. What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?

Finnish Patent Act, Section 2 provides that an invention must **differ essentially** from the prior art known before the date of filing of the patent application. In other words, the essential difference is the requirement for inventive step.

The Finnish Patent Act and Patent Decree do not provide any further definition on how to evaluate inventive step.

According to the Patent Manual, used as Examination guidelines in the Finnish Patent Office, chapter E.3.5.1, **the invention involves inventive step, if it is not obvious for a person skilled in the art on the basis of the known prior art.** The term “obvious” is defined to be something “that does not go beyond a normal progress of technology but plainly and logically results from the known prior art, without requiring a performance exceeding the normal skills and capabilities of a skilled person in the art”.

2. Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?

There have been no changes in the Finnish Patent Act and Patent Decree regarding the definition of inventive step.

However, with Finland joining the EPC in March 1996 the Finnish Patent Office started adopting the practice of the EPO to a large degree. With this the concept of the problem-solution approach has been introduced, being nowadays the primary method for evaluating inventive step in the Finnish Patent Office.

3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?

Yes, examination guidelines on inventive step are published in the Patent Manual (See point 1 above).

The Patent Manual describes the problem-solution approach for evaluating inventive step in detail, similarly as in the Guidelines for Examination of the EPO.

The Examiners follow the Patent Manual quite strictly, and therefore the guidelines are useful in the prosecution before the Finnish Patent Office.

4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?

During the invalidity proceedings, the standard for inventive step seems to be lower than in the examination or opposition proceedings.

During the invalidity proceedings, the same methods for evaluating inventive step are applied, in principle. In practice, the application of the problem-solution approach seems to be slightly different from that used in the examination proceedings. In the invalidity proceedings, the problem originally presented in the patent itself may often establish the problem used in the evaluation of inventive step, instead of an objective problem formulated based on the differences between the invention and the closest prior art.

Construction of claims and interpretation of prior art

5. How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?

This is not stated clearly anywhere.

However, Patent Act, Section 39 provides that the scope of the patent is defined by the claims, and that the description may be used to understand the claims. The claims are read as would be understood by a person skilled in the art in the light of the description.

6. Is it possible to read embodiments from the body of the specification into the claims?

Not directly, but the specification can be used to understand the claims.

7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?

The prior art is interpreted in the view of the person skilled in the art on the day before the priority date.

Common general knowledge of a person skilled in the art can be combined with a prior art document to make that prior art document alone relevant against inventive step (Patent Manual, chapter E.3.5.3.).

Reliance on inherent disclosure is permitted. A prior art document may be interpreted to encompass a feature that is not explicitly disclosed, if the definition of a technical implementation in the prior art document is such that the implementation necessarily requires such feature (Patent Manual, chapter E.3.4.1.,).

8. Do the answers to any of the questions above differ during examination versus during litigation?

No.

Combination or modification of prior art

9. Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference?

Yes. "Common general knowledge" can be combined with a prior art document alone or with different parts from a same prior art document against inventive step (Patent Manual, chapter E.3.5.3.).

If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?

The Patent Manual, chapter E.3.2.2., defines that "common general knowledge" is everything the skilled person would know. "Common general knowledge" need not be based on a written disclosure or relate to any particular publication. Basic text books and handbooks usually present "common general knowledge". A single patent document or scientific document does not make the information to be "common general knowledge".

The Finnish Patent Office also uses (according to the Patent Manual) the could-would approach similar to that of the EPO. In other words, it is required that the person skilled in the art 'would' have reached the solution of the claims based on the prior art, and it is not enough that he/she just 'could' have done so. There needs to be a reason for the skilled person to reach the same solution. What is the criterion for this "reason" has not been defined any further in the Patent Manual.

10. What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?

According to the Patent Manual (chapter E.3.5.3) the following is considered in evaluating the capability of the person skilled in the art to combine two or more prior art references:

- 1) Are the contents of the documents such that it would be likely for the person skilled in the art to combine them?
- 2) Are the documents to be combined from the same, from neighbouring or from distant technical fields?
- 3) the number of documents to be combined.

Combining two documents is obvious if there is a natural reason for a person skilled in the art to combine them. There needs to be a reason why the skilled person would have used particular documents in seeking a solution to the problem, and the reason needs to show why it would be obvious to combine them.

An explicit teaching or motivation to combine is not required, but it is considered obvious to combine two documents, if there is a reference in one of the documents to the other.

- 11. When two or more prior art references are, combined, how relevant is the closeness of the technical field to what is being claimed? How relevant is the problem the inventor of the claim in question was trying to solve?**

See question 10.

The closeness of the technical fields is relevant but the problem the inventor of the claim in question was trying to solve is not primarily considered.

As a starting point, the person skilled in the art possesses skills only in the technical field or fields to which the claimed invention belongs, although he/she also has knowledge relating to technical fields close to or corresponding to the technical field of the invention.

- 12. Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?**

Yes, it is permitted but if several documents need to be combined to get to the solution, then this starts to be a sign of inventiveness (Patent Manual, chapter E.3.5.3).

No, the standard for combining two or more references is the same that was explained in the answer to question 10.

- 13. Do the answers to any of the questions above differ during examination versus during litigation?**

Not otherwise but the problem the inventor of the claim in question was trying to solve is more relevant during litigation procedures than in examination procedures?

Technical Problem

- 14. What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?**

It plays an important role. It is examined, based on the references, whether the skilled person would reach the same solution.

- 15. To what degree, if any, must the technical problem be disclosed or identified in the specification?**

The technical problem need not be disclosed or identified in the specification, as the objective technical problem formulated according to the problem-solution approach does not need to be the same as the technical problem that has possibly been disclosed in the specification.

Advantageous effects

16. What role, if any, do advantageous effects play in determining inventive step or non-obviousness?

The invention does not need to be an improvement over prior art. It can as well be an alternative solution with similar effects or merely economic benefits. However, advantages can function as an indication of inventive step (Patent Manual, chapter E.3.5.5).

17. Must the advantageous effects be disclosed in the as-filed specification?

No. However, it is encouraged in the Patent Manual (chapter H.3.5.5) to mention technical evolution or improvements in the specification as filed

18. Is it possible to have later-submitted data considered by the Examiner?

Yes, at least concerning the technical effect or reproducibility of the invention (Patent Manual, chapter H.3.3.2).

19. How “real” must the advantageous effects be? Are paper or hypothetical examples sufficient?

The Patent Office does not question the alleged effects presented by the applicant but primarily considers them to be correct.

20. Do the answers to any of the questions above differ during examination versus during litigation?

In litigation a technical advantage of the allegedly infringing object may help avoiding an interpretation of infringement by equivalent means. However, also here it is a question of non-obviousness.

Teaching away

21. Does your jurisdiction recognize teaching away as a factor in favor of inventive step / non-obviousness? Must the teaching be explicit?

Yes. Patent Manual (chapter E.3.5.5.) states this as an additional indication of inventive step. This does not need to be stated in the specification as filed nor in the prior art, but is enough that it is visible e.g. from the prior art references or as compared to the prior art references.

22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?

This can be an important proof of inventive step unless the earlier teaching was obviously erroneous (Patent Manual, chapter E.3.5.5).

23. Is there any difference in how teaching away is applied during examination versus in litigation?

No.

Secondary considerations

24. Are secondary considerations recognized in your jurisdiction?

Yes.

25. If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the claimed invention and the secondary considerations required?

At least the following:

- i. many have tried to solve the problem without success
- ii. works against earlier technical prejudice
- iii. teaching away from earlier solutions (as in questions 21-23)
- iv. technical evolution or improvement
- v. commercial success

26. Do the answers to any of the questions above differ during examination versus during litigation?

No.

Other considerations

27. In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction?

If yes, please describe these issues, tests, or factors.

No.

Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and , if so, provide a brief summary of such interpretation.

The problem-solution approach.

29. Does such test differ during examination versus during litigation?

No.

Patent granting authorities versus courts

30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.

No.

- 31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?**

No.

Regional and national patent granting authorities

- 32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?**

No.

- 33. If yes, is this problematic?**

II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

- 34. Is harmonization of inventive step / non-obviousness desirable?**

Yes, to ensure commensurate scope of protection throughout the world.

- 35. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?**

We doubt it. The US, European and Japanese Patent Offices have very different standards. Further, in common law countries the case law evolves independently of any universal standards pursued.

- 36. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.**

We could not figure out any globally applicable definition.

- 37. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.**

The problem-solution approach is considered to be the most promising universal method for determining inventive step.

Summary

The Finnish AIPPI Group notes that the standard for inventive step is well established in Finland and substantially in line with that of the European Patent Office. The Finnish AIPPI Group is in favour of the harmonization of the standard for evaluating inventive step and considers the problem-solution approach to be the most promising universal method.

Résumé

Le groupe finlandais de l'AIPPI constate que le critère de l'activité inventive est bien établi en Finlande et sensiblement conforme à celui de l'Office Européen des Brevets. Le groupe finlandais de l'AIPPI est pour l'harmonisation du critère d'évaluation de l'activité inventive et d'avis que l'approche problème-solution est la méthode universelle la plus prometteuse.

Zusammenfassung

Die finnische AIPPI Gruppe bringt vor, dass der Standard für die erfinderische Tätigkeit ist gut etabliert auch in Finnland und im Wesentlichen im Einklang mit dem des Europäischen Patentamts. Die finnische AIPPI Gruppe spricht sich für die Harmonisierung der Standards für die Bewertung der erfinderischen Tätigkeit und betrachtet das Aufgabe-Lösungs-Ansatz für die aussichtsreichsten universelle Methode.